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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,880	12/08/2003	Michael J. Shea	EX-4-COMM	9623
40283	7590	07/13/2006	EXAMINER	
MICHAEL J. SHEA 1726 CREEK CROSSING ROAD VIENNA, VA 22182			SYED, FARHAN M	
			ART UNIT	PAPER NUMBER
			2165	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/728,880	Applicant(s) SHEA, MICHAEL J.	
	Examiner Farhan M. Syed	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20031208</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-45 are pending.

Drawings

2. The drawings are objected to because item 106 that is indicated in Figures 8A, 9, and 10 is not mentioned in the specification when describing the respective figures.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: items 102 and 503 of Figure 10; items 301 and 303 of Figure 13B; item 353 of Figure 15B. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: items 317 and 355 of Figure 15C; items 316, 317 and 355 in Figure 15B. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are

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not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 25, 29, and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 25, 29, and 44 recite the limitations of using a storage medium for storing instructions, however the Applicant's specification fails to describe the storage medium. In light of further prosecution of these claims, the Examiner will assume that the Applicant means a storage medium to mean a local hard disk.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 14 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claims 14 and 37, the word "means" is preceded by the word(s) "comprising" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 5-11, 13-15, 19-26, and 28-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al (U.S. Patent No. 6,615,214 and known hereinafter as Miller).

As per claims 1, 14, 15, 30, 31, 37, 38, and 45, Miller teaches a system for communicating exerciser-related messages comprising (i.e. *"This invention concerns electronic mail, and in particular a correspondent-centric way of organizing and processing e-mail to enhance setup, ease of use, convenience, storage, and functionality of e-mail."* *"These e-mail softwares store and let the user view these messages in a standard way, using designated files (also called "mailboxes" or "folders"). The default files are typically an "Inbox" and an "Outbox." When a user sends a message the software typically creates a message text string which it appends to the sender's "Out" file, then transmits the string over the network to the receiver's e-mail system, where the text string is appended to sender's "In" file."* The preceding text clearly indicates that a system for communicating messages is the electronic mail and processing e-mail. Communicating exerciser-related messages is merely an intended use of the prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).)(Column 1, lines 11-14; column 2, lines 21-28): a database storing records of exercise activities for a plurality of exercisers (i.e. *"Flat-file database, also called also "non-relational" databases, store information as a simple series of "records", each containing identical "fields" of information (like subsequent rows a spreadsheet, each containing one field of information for each column of the spreadsheet)." The preceding text clearly indicates that non-relational database contains a set of records containing fields of information, which are storing records. The storing records of exercise activities for a plurality of exercisers are merely the intended use of the prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963).)(Column 3, lines 57-60); a processing system generating messages relating to one or more of the exercisers based on the records of exercise activities (i.e. *"New message processing 400 starts after a message is received by mail host 105 or 205 and has been transmitted by**

the mail host to user interface application 111 or 211." The preceding text clearly indicates that a processing system is the new message processing.)(Column 8, lines 26-29); and a communication network interface communicating the messages over a communication network (i.e. *"In FIG. 2 incoming e-mail comes to mail host 205, and is transmitted through network 217 to user 221's client e-mail computer 219, as would typically happen without the invention in traditional e-mail systems."* The preceding text clearly indicates that a communication network interface communicating is transmitting e-mails through a network to a user's computer. An ordinary person skilled in the art understands that in order to transmit data from the network to a computer, the computer must contain a communication network interface.)(Column 7, lines 63-66).

As per claims 5, 19, 33, and 40 Miller teaches a system wherein the messages comprise e-mail messages (i.e. *"In host-based e-mail systems, on the other hand, messages are stored and processed on the server rather than the client."*)(Column 1, lines 57-58).

As per claims 6 and 20, Miller teaches a system wherein the messages are communicated over the communication network to the one or more exercisers (i.e. *"In FIG. 2 incoming e-mail comes to mail host 205, and is transmitted through network 217 to user 221's client e-mail computer 219, as would typically happen without the invention in traditional e-mail systems."* *"The user can open an e-mail window pre-addressed to multiple users by clicking on boxes in the three columns in 703, then clicking on the confirm button 711 below."*)(Column 7, lines 63-66; Column 9, lines 59-61).

As per claims 7 and 21, Miller teaches a system wherein the messages are communicated over the communication network to fitness consultants for the one or

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more exercisers (i.e. *"In FIG. 2 incoming e-mail comes to mail host 205, and is transmitted through network 217 to user 221's client e-mail computer 219, as would typically happen without the invention in traditional e-mail systems."* *"The user can open an e-mail window pre-addressed to multiple users by clicking on boxes in the three columns in 703, then clicking on the confirm button 711 below."*)(Column 7, lines 63-66; Column 9, lines 59-61).

As per claims 8, 22, 34 and 41, Miller teaches a system wherein the database stores e-mail addresses for the exercisers and the messages comprise e-mail messages communicated over the communication network to the one or more exercisers using the e-mail addresses (i.e. *"The E-Mail Box data table 987 also contains fields for storing other information relating to each of the Users' E-Mail Boxes, such as an arbitrary title the users may name their E-Mail Box and also an identifier for E-Mail Box type. Types of E-Mail Boxes which the invention uses included Trusted (meaning the address is used only for correspondence with correspondents E-Mail Box 987. The minimum information which about each correspondent which is maintained in the User-Correspondent data table is the correspondent's e-mail address. Other information about correspondents in the User-Correspondent data table may include first and last name, description, comments, phone, address, etc."* *"All messages, whether incoming or outgoing, are stored in Message data table 993, which is similar to Message Data Stores 107 and 209."*)(Column 13, lines 23-35 and 65-67).

As per claims 9 and 23, Miller teaches a system wherein the messages comprise requests for replies from the one or more exercisers regarding their exercise activities (i.e. *"For example, an employee survey sent by e-mail may request the user to indicate his or her sex."*)(Column 3, lines 12-13).

As per claims 10 and 24, Miller teaches a system wherein the processing system updates the records of exercise activities of replying exercisers based on their replies (i.e. *"When user changes his e-mail address, automates notification of user's chosen correspondents, and in some cases can automatically update such correspondents' e-mail address lists."*)(Abstract).

As per claims 11 and 26, Miller teaches a system wherein the processing system generates the messages automatically (i.e. *"When user changes his e-mail address, automates notification of user's chosen correspondents, and in some cases can automatically update such correspondents' e-mail address lists."*)(Abstract).

As per claims 13, 28, 36, and 43, Miller teaches a system wherein the database comprises one or more portions that are remotely accessible to the exercisers (i.e. *"FIG. 9D shows the internal structure of the Mass Storage Server (909). As shown in FIG. 9D, a Mass Storage Interface 951 provides high level methods that will be called by the Object Insertion Module (945) through RMI (Remote Method Invocation) to store Message Objects. The Mass Storage Interface 951 is the responsible for the actual communication with the Mass Storage Server, also referred to as the Database(953). The Mass Storage (953) is the actual location for storing and manipulating users' Messages, Correspondents, and Topic information. See FIG. 9-F for details on the entity relationship diagram of the database."*)(Column 12, lines 3-13).

As per claims 25, 29, and 44, Miller teaches a storage medium storing instructions that are executable to perform the method (i.e. *"In apparatus 200 message data store 107 and correspondent data store 113 (from apparatus 100) are combined into local hard disk 208, which contains message data store 209 and correspondent data store 215 for a single user, rather than for multiple users 109(a . . . n) and 115(a . . . n) in 107 and 113 in apparatus 100."*)(Column 8, lines 1-10).

As per claim 35, the limitations of this claim has been addressed and/or rejected based on the dependency of claim 31.

As per claim 39, Miller teaches a method further comprising: receiving reply messages from the one or more exercisers regarding the workouts (i.e. *"For example, an employee survey sent by e-mail may request the user to indicate his or her sex."*)(Column 3, lines 12-13); and updating the data in the database based on the received reply messages (i.e. *"When user changes his e-mail address, automates notification of user's chosen correspondents, and in some cases can automatically update such correspondents' e-mail address lists."*)(Abstract).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-4, 12, 16-18, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (U.S. Patent No. 6,615,214 and known hereinafter as Miller) in view of Reed et al (U.S. Patent No. 6,044,205 and known hereinafter as Reed).

As per claims 2 and 16, Miller does not explicitly teach a system wherein the messages are generated based on when the exercisers performed exercise activities.

Reed teaches a system wherein the messages are generated based on when the exercisers performed exercise activities (i.e. *"Additionally, receipt and storage of the new or updated information can trigger other actions, such as automatically forwarding the information to another consumer, exchanging information with the consumer database 21, sending an automated response to the provider, or sending a message to another software program on the consumer's desktop. Again, this invention provides a means for such actions to be cooperatively controlled by both the provider and the consumer through the use of object methods, which is discussed below."*)(Column 10, lines 27-38).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Miller with the teachings of Reed to include a system wherein the messages are generated based on when the exercisers performed exercise activities with the motivation to coordinate the transfer and content of data, metadata, and instructions between databases in order to simplify, automate, and increase the intelligence of communications (Reed, column 1, lines 10-12).

As per claims 3 and 17, Miller does not explicitly teach a system wherein the messages are generated based on whether the exercisers have performed exercise activities for a certain period of time.

Reed teaches a system wherein the messages are generated based on whether the exercisers have performed exercise activities for a certain period of time (i.e. *"The triggering of update methods is typically controlled by a system event in the consumer program 22. Alternatively, it could be triggered by the receipt of an update trigger message from the provider program 12. The timing of the system event is controlled by one or more preferences stored in the consumers*

global preferences instance (114, FIG. 3). Thus, the system event could happen upon startup of the consumer program 22, at a periodic interval during the programs operation, at a specific time of day, etc. The system event could also be dependent on monitoring the system activity level of the consumer computer 2, or on other system or environment variables.”(Column 38, lines 37-48).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Miller with the teachings of Reed to include a system wherein the messages are generated based on whether the exercisers have performed exercise activities for a certain period of time with the motivation to coordinate the transfer and content of data, metadata, and instructions between databases in order to simplify, automate, and increase the intelligence of communications (Reed, column 1, lines 10-12).

As per claims 4 and 18, Miller does not explicitly teach a system wherein the messages are generated based on physiological data for the exercisers measured during exercise activities.

Reed teaches a system wherein the messages are generated based on physiological data for the exercisers measured during exercise activities (i.e. “Additionally, receipt and storage of the new or updated information can trigger other actions, such as automatically forwarding the information to another consumer, exchanging information with the consumer database 21, sending an automated response to the provider, or sending a message to another software program on the consumer's desktop. Again, this invention provides a means for such actions to be cooperatively controlled by both the provider and the consumer through the use of object methods, which is discussed below.”) (Column 10, lines 27-38).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Miller with the teachings of Reed to include a system wherein the messages are generated based on physiological data for the exercisers measured during exercise activities with the motivation to coordinate the transfer and content of data, metadata, and instructions between databases in order to simplify, automate, and increase the intelligence of communications (Reed, column 1, lines 10-12).

As per claims 12 and 27, Miller does not explicitly teach a system wherein the processing system generates the messages automatically on a periodic basis.

Reed teaches a system wherein the processing system generates the messages automatically on a periodic basis (i.e. *"The triggering of update methods is typically controlled by a system event in the consumer program 22. Alternatively, it could be triggered by the receipt of an update trigger message from the provider program 12. The timing of the system event is controlled by one or more preferences stored in the consumers global preferences instance (114, FIG. 3). Thus, the system event could happen upon startup of the consumer program 22, at a periodic interval during the programs operation, at a specific time of day, etc. The system event could also be dependent on monitoring the system activity level of the consumer computer 2, or on other system or environment variables."*) (Column 38, lines 37-48).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Miller with the teachings of Reed to include a system wherein the processing system generates the messages automatically on a periodic basis with the motivation to coordinate the transfer and content of data,

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metadata, and instructions between databases in order to simplify, automate, and increase the intelligence of communications (Reed, column 1, lines 10-12).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farhan M. Syed whose telephone number is 571-272-7191. The examiner can normally be reached on 8:30AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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FMS